UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,264	12/03/2003	Bret Alan Gorsline	002566-73 (019000)	4901

22204 7590 01/11/2006

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER	
FABER, DAVID	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,264	GORSLINE ET AL.	
	Examiner	Art Unit	
	David Faber	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the application filed 3 December 2003.

This action is made Non-Final.

2. Claims 1 - 45 are pending. Claims 1, 8, 15, 16, 17, 30, 44 and 45 are independent claims.

Drawings

3. The drawings filed on 3 December 2003 are accepted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 8-11, 15-17, 18-19, 30-32, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Evan et al.

As per independent Claim 1, Evans et al discloses a method comprising:

- receiving an aggregate creative definition; (Paragraph 0058; FIG 3, 302-304 - Discloses a number of advertising formats the user is able to choose from. Once the format is selected, the user chooses from a plurality of templates related to the advertising format. (Paragraph 0063))

- constructing a container in accordance with the aggregate creative definition; (Each template contains one or more ad areas where the ad area is configured to be different shapes, and sizes to contain images and text. These areas include the use of custom text describing a product or overall advertisement (Paragraph 0068 - Paragraph 0069))
- receiving a plurality of subcreatives associated with the aggregate creative definition for selective combination with the container; (Paragraph 0066 discloses a user is represented with options of pre-defined products ads, as well as new product ads the user may create. Paragraph 0071 discloses the inputting of user-inputted product references that include an image of the product and text to describe it, into the ad area of the template.)
- operating the aggregate creative definition to selectively assemble a plurality of aggregate creative forms, each of the plurality of aggregate creative forms comprising at least one combination of a selected subcreative from the plurality of subcreatives with the container; and (Paragraph 0048, FIG 3 discloses one embodiment of the overall process of creating an computer-created advertisement. First, the user selects an advertisement format then chooses a template based on the advertisement format. Then the user is given various product references options to choose from to display on the advertisement template. Each template may contain multiple ad areas (Paragraph 0069) which each ad area able to contain one or more product references (Paragraph 0068, Page 6, lines 5 – 14; Paragraph 0071. Since the

template is customizable by the user, such as inputting new product ads and references onto the template (Paragraph 0079), it provides greater flexibility creating multiple advertisements.)

- storing the plurality of aggregate creative forms for transmission to users on an electronic network. (Paragraph 0091 discloses the user accounts service that provides access to a memory storage device that the user may store data. Thus, a user using an Internet connection may store product references, templates and other custom information such as user's files, and data. Paragraph 0091 also discloses of an autosave feature being able to save the advertisement anytime during the advertisement creation. Thus, then the final advertisement maybe sent via email or posted on a website in an electronic advertisement. (Paragraph 0052))

As per dependent Claim 2, Evan et al discloses:

- wherein the aggregate creative definition is selected from the group comprising templates, data files and software programs. (Paragraph 0062 – User selects a template of the advertisement format desired for creation.)

As per dependent Claim 3, Evan et al discloses:

- wherein each of the plurality of subcreatives comprises at least one of the group comprising text, a graphic and a hyperlink. (Paragraph 0071, lines 5-8)

As per dependent Claim 4, Evan et al discloses:

- wherein each of the plurality of subcreatives is associated with at least one pool of subcreatives. (Paragraph 0066 discloses the use of pre-defined product ads, the use of user-created product ads. Paragraph 0071 also discloses the use of adding product references, which include product ads and described text, to the template. These product references are retrievable from one or more databases. (Paragraph 0076-0077))

As per independent Claim 8, Claim 8 recites a system for performing similar limitations as of Claim 1 and is rejected under rationale. Furthermore, Evan et al discloses a system comprising:

- a processor (FIG 1, 106)
- a memory connected to the process and storing instructions to control the operation of the processor (FIG 1, 108; Its inherent that memory is used for store instructions to be processed by the processor.)

As per dependent Claim 9, Claim 9 recites similar limitations as in Claim 2 and is similarly rejected under Evan et al.

As per dependent Claim 10, Claim 10 recites similar limitations as in Claim 3 and is similarly rejected under Evan et al.

As per dependent Claim 11, Claim 11 recites similar limitations as in Claim 4 and is similarly rejected under Evan et al.

As per independent Claim 15, Claim 15 recites a system for performing the method of Claim 1. Therefore, Claim 15 is similarly rejected under Evan et al.

As per independent Claim 16, Claim 16 recites a program product comprising a storage device containing instructions operable on a computer for performing the method of Claim 1. Therefore, Claim 16 is similarly rejected under Evan et al.

As per independent Claim 17, Evan et al discloses a method:

- receiving an aggregate creative definition for assembling an aggregate creative; (Paragraph 0058; FIG 3, 302-304 - Discloses a number of advertising formats the user is able to choose from. Once the format is selected, the user chooses from a plurality of templates related to the advertising format. (Paragraph 0063))
- receiving a plurality of subcreatives for selective combination with the aggregate creative definition; (Paragraph 0066 discloses a user is represented with options of pre-defined products ads, as well as new product ads the user may create. Paragraph 0071 discloses the inputting of user-inputted product references that include an image of the product and text to describe it, into the ad area of the template.)
- operating the aggregate creative definition to selectively assemble a plurality of aggregate creative forms, (Paragraph 0048, FIG 3 discloses one embodiment of the overall process of creating a computer-created advertisement. First, the user selects an advertisement format then chooses a

template based on the advertisement format. Then the user is given various product references options to choose from to display on the advertisement template. Each template may contain multiple ad areas (Paragraph 0069) which each ad area able to contain one or more product references (Paragraph 0068, Page 6, lines 5 – 14; Paragraph 0071. Since the template is customizable by the user, such as inputting new product ads and references onto the template (Paragraph 0079), it provides greater flexibility creating multiple advertisements.)

- storing the plurality of aggregate creative forms; (Paragraph 0091 discloses the user accounts service that provides access to a memory storage device that the user may store data. Thus, a user using an Internet connection may store product references, templates and other custom information such as user's files, and data. Paragraph 0091 also discloses of an autosave feature being able to save the advertisement anytime during the advertisement creation. Thus, then the final advertisement maybe sent via email or posted on a website in an electronic advertisement. (Paragraph 0052))
- storing a plurality of non-aggregate creatives; and (Paragraph 0091 discloses an embodiment of saving user's data that includes advertisements, images, text, etc. In addition, Paragraph 0070 discloses the use of ad themes and the able to save the ad themes for future use)
- operating the advertising system to select one of the plurality of aggregate creative forms or one of the plurality of non-aggregate creatives for

transmission to a viewer. (Paragraph 0052: The user specifies the final advertisement may be transmitted to a target audience by email or posted on a one or more websites.)

As per dependent Claim 18, Evan et al discloses a method further:

- transmitting the selected one of the plurality of aggregate creative forms or one of the plurality of non-aggregate creatives to the viewer over an electronic network. (Paragraph 0052: Transmitted via email or posted on web sites.)

As per dependent Claim 19, Evan et al discloses a method:

- the electronic network is the Internet (Paragraph 0052: Discloses that the advertisement may be posted on one or more web sites. Thus, since the Internet consists of being interlinked with a collection of web sites and pages, the Internet is used to have the ad posted on a web site)

As per independent Claim 30, Claim 30 recites a system for performing similar limitations as of Claim 17 and is rejected under rationale. Furthermore, Evan et al discloses a system comprising:

- a processor (FIG 1, 106)
- a memory connected to the process and storing instructions to control the operation of the processor (FIG 1, 108; Its inherent that memory is used for store instructions to be processed by the processor.)

As per dependent Claim 31, Claim 31 recites similar limitations as in Claim 18 and is similarly rejected under Evan et al.

As per dependent Claim 32, Claim 32 recites similar limitations as in Claim 19 and is similarly rejected under Evan et al.

As per independent Claim 44, Claim 44 recites a system for performing the method of Claim 17. Therefore, Claim 44 is similarly rejected under Evan et al.

As per independent Claim 45, Claim 45 recites a program product comprising a storage device containing instructions operable on a computer for performing the method of Claim 17. Therefore, Claim 45 is similarly rejected under Evan et al.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5, 12, 20-21, 24-27, 33-34, and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Larson (US PG Pub 20020188635, published 12/12/2002)

As per dependent Claim 5, Claim 5 recites similar limitations as in Claim 1 and is rejected under rationale. Furthermore, Evan et al fails to specifically disclose that the step of operating the aggregate creative definition to selectively assemble a plurality of

aggregate creative forms includes the step of rotating the selection of subcreatives within the plurality of aggregate creative forms. However, Larson discloses the use of a preview (reduced-sized; Paragraph 0061) image display advertisements depicted in various preferred locations in an automatically rotating fashion. Larson discloses that the ads may periodically exchange places after a specified amount of time such as hourly or daily. (Paragraph 0138-0139)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Evan et al's method with Larson's method since Larson's method would have provided digital edition web pages that incorporated preview images of advertising hard copy.

As per dependent Claim 12, Claim 12 recites similar limitations as in Claim 5 and is similarly rejected under Evan et al and Larson.

As per dependent Claims 20 and 21, Claims 20 and 21 recites similar limitations as in Claim 17 and is rejected under rationale. Furthermore, Evan et al fails to specifically disclose periodically repeating the step of operating the aggregate creative definition to selectively assemble a plurality of aggregate creative forms in accordance with a predefined plan of rotation of said plurality of subcreatives or periodically repeating the step of operating the advertising system to select one of the plurality of aggregate creative forms and non-aggregate creatives in accordance with a predefined rotation plan.. However, Larson discloses the use of preview (reduced-sized; Paragraph 0061) image display advertisements depicted in various preferred locations in an

automatically rotating fashion. Larson discloses that the ads may periodically exchange places after a specified amount of time such as hourly or daily. (Paragraph 0138-0139)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Evan et al's method with Larson's method since Larson's method would have provided digital edition web pages that incorporated preview images of advertising hard copy.

As per dependent Claim 24, Evan et al discloses:

- wherein the aggregate creative definition is selected from the group comprising templates, data files and software programs. (Paragraph 0062 – User selects a template of the advertisement format desired for creation.)

As per dependent Claim 25, Evan et al discloses:

- wherein each of the plurality of subcreatives comprises at least one of the group comprising text, a graphic and a hyperlink. (Paragraph 0071, lines 5-8)

As per dependent Claim 26, Evan et al discloses:

- wherein each of the plurality of subcreatives is associated with at least one pool of subcreatives. (Paragraph 0066 discloses the use of pre-defined product ads, the use of user-created product ads. Paragraph 0071 also discloses the use of adding product references, which include product ads

and described text, to the template. These product references are retrievable from one or more databases. (Paragraph 0076-0077))

As per dependent Claim 27, Claim 27 recites similar limitations as in Claim 5 and is similarly rejected under Evan et al and Larson.

As per dependent Claims 33 and 34, Claims 33 and 34 recites similar limitations as in Claims 20 and 21 and are similarly rejected under Evan et al and Larson.

As per dependent Claim 37, Claim 37 recites similar limitations as in Claim 24 and is similarly rejected under Evan et al.

As per dependent Claim 38, Claim 38 recites similar limitations as in Claim 25 and is similarly rejected under Evan et al.

As per dependent Claim 39, Claim 39 recites similar limitations as in Claim 26 and is similarly rejected under Evan et al.

As per dependent Claim 40, Evan et al discloses:

- an aggregate creative is associated with a plurality of pools of subcreatives. . (Paragraph 0066 discloses the use of pre-defined product ads, the use of user-created product ads, which are saved to the template after selecting. Paragraph 0071 also discloses the use of adding product references, which include product ads and described text, to the template. These product references are retrievable from one or more databases. (Paragraph 0076-

0077))

As per dependent Claim 41, Claim 41 recites similar limitations as in Claim 5 and is similarly rejected under Evan et al and Larson.

8. Claims 6-7, 13-14, 22-23, 28-29, 35-36, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Larson (US PG Pub 20020188635, published 12/12/2002) in further view of Alao et al (US PGPub 20020147645, published 10/10/2002)

As per dependent Claims 6 and 7, Evan et al and Larson fail to specifically disclose that the step of rotating is performed with weighting of selected subcreatives and with constraints on the selection of the plurality of subcreatives. However, Alao et al discloses how advertisements are to be chosen based on constraints such as advertisement priority, advertisement weight, minimum advertisement display time, industry exclusions, overall frequency cap, minimum rotation interval, advertisement spec, advertisement type, and advertisement target. (Paragraph 0146, lines 15-21) Alao et al further details how ad-weighting works based on priority. (Paragraph 0146, lines 21-29)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Evan et al and Larson's method with Alao et al's method since Alao et al's method would have provided a method for adaptive delivery of advertisements to a client.

As per dependent Claims 13 and 14, Claims 13 and 14 recites similar limitations as in Claims 6 and 7 and are similarly rejected under Evan et al, Larson and Alao et al.

As per dependent Claims 22 and 23, Evan et al and Larson fail to specifically disclose that the subcreatives selected for inclusion in the aggregate creative forms are selected in accordance with a first weighting and the aggregate creative forms selected for transmission to a viewer are selected in accordance with a second weighting or the subcreatives selected for inclusion in the aggregate creative forms are selected in accordance with a first constraint and the aggregate creative forms selected for transmission to a viewer are selected in accordance with a second constraint. However, Alao et al discloses how advertisements are to be chosen based on constraints such as advertisement priority, advertisement weight, minimum advertisement display time, industry exclusions, overall frequency cap, minimum rotation interval, advertisement spec, advertisement type, and advertisement target. (Paragraph 0146, lines 15-21) Alao et al further details how ad-weighting works based on priority. (Paragraph 0146, lines 21-29) Alao et al's method disclosure of one embodiment would also allow different ads to be weighted and have constraints in which this method can be done repeatedly for different advertisements.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Evan et al and Larson's method with Alao et al's method since Alao et al's method would have provided a method for adaptive delivery of advertisements to a client.

As per dependent Claims 28 and 29, Claims 28 and 29 recites similar limitations as in Claims 6 and 7 and are similarly rejected under Evan et al, Larson and Alao et al.

As per dependent Claims 35 and 36, Claims 35 and 36 recites similar limitations as in Claims 22 and 23 and are similarly rejected under Evan et al, Larson and Alao et al.

As per dependent Claims 42 and 43, Claims 42 and 43 recites similar limitations as in Claims 6 and 7 and are similarly rejected under Evan et al, Larson and Alao et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ozer et al (US PGPub 20030110171: Discloses selectively displaying advertisements)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Faber
Patent Examiner
AU 2178

STEPHEN HONG
SUPERVISORY PATENT EXAMINER